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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,741	09/25/2000	Takashi Sawaguchi	PM 273965 P8412	1644

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EXAMINER

MCARDLE, JOSEPH M

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/668,741

Applicant(s)

SAWAGUCHI, TAKASHI

Examiner

Joseph McArdle

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Claims 1 and 2 are objected to because of the following informalities: line 7 of claim 1 reads as "authentication data being data." The examiner notes that it should read as "authentication data being read." Lines 3 and 4 of claim 2 both recite the phrase "man". The examiner notes that this should read as "man's" appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-4, 14-18, 21-23 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Burger (6219439). In regards to claim 1, Burger discloses a design in column 4, lines 34-42 that pertains to a portable, hand-held biometric personal authentication device. Burger then discloses in column 5, lines 6-19 that a reader includes a fingerprint scanner to be used for extracting biometric data (i.e. fingerprints) for the purposes of authenticating a user. Burger finally discloses in the aforementioned

location that a control chip is used to control communications for the reader. These disclosures meet the exact limitations set forth under claim 1, which call for having a portable personal authentication apparatus that has both communication means and reading means for reading biological features that will be used for authentication purposes.

3. In regards to claim 2, Burger discloses in column 5, lines 6-19 (as mentioned in the rejection of claim 1 above) that a reader includes a fingerprint scanner for obtaining biological data to be used for authentication purposes. This disclosure meets the exact limitations set forth under claim 2.

4. In regards to claims 3 and 4, Burger provides an example of how the personal authentication device may be used in column 4, lines 39-42. Burger's example describes how the personal authentication device can be connected to a computer of a purchaser (user) in order to authenticate the purchaser (user) before a seller on the Internet releases the desired products or services. This disclosure meets the limitations set forth under claims 3 and 4 that call for using the personal authentication apparatus in an electronic system in order to allow a user to be authenticated before they can use the system.

5. In regards to claims 14-18, Burger discloses in column 5, lines 21-23 and in figure 1 how a smart card representative of the personal authentication device can be inserted into a card reader slot that is capable of reading the aforementioned biological data (fingerprint data). This disclosure meets the exact limitations set forth under claims 14-18.

6. In regards to claims 21-23 and 26 Burger discloses in column 4, lines 39-42 (as mentioned in the rejection of claim 3 above) that the personal authentication device can be connected to a computer of a purchaser (user) in order to authenticate the purchaser (user) before a seller on the Internet releases the desired products or services. This disclosure meets the exact limitations set forth under claim 21-23 and 26.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5-10, 11-13, 19, 20, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger in view of Rosen (5799087). In regards to claims 5-7, Burger's design disclosed above meets all of the aforementioned limitations of claims 1-3. However, Burger's design makes no mention of allowing the electronic system to be an electronic commerce system in which electronic cash is created by giving monetary value to information flowing on a communication network. Burger's design also makes no mention of settling business transactions with stored electronic cash. Rosen teaches in column 2, lines 34-51 how there is a need to have an electronic commerce system that is capable of allowing individual subscribers to acquire electronic money for the purposes of performing economic exchanges without the intermediation of a

conventional banking system. Rosen further discloses in column 3, lines 31-35 a design in which transaction devices (such as the personal authentication apparatus) are used to store electronic money to be used for economic exchanges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Rosen's teachings on the need for having an electronic commerce system that allows individual users to acquire and store electronic cash on transaction devices into Burger's design in order to achieve a design that is capable of authenticating a user to participate in an electronic commerce system that utilizes electronic cash for the purposes of performing electronic exchanges.

9. In regards to claims 8-10, Burger's design disclosed above meets all of the aforementioned limitations of claims 1-3. However, Burger's design makes no mention of including a storage means in the personal authentication device for storing credit information to be used for electronic commerce. Rosen teaches in column 2, lines 34-51 how there is a need to have an electronic commerce system that is capable of allowing individual subscribers to acquire electronic money for the purposes of performing economic exchanges without the intermediation of a conventional banking system. Rosen further discloses in column 3, lines 31-35 a design in which transaction devices (such as the personal authentication apparatus) are used to store electronic money to be used for economic exchanges. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Rosen's teachings on the need for having an electronic commerce system that allows individual users to acquire and store electronic cash on transaction devices into Burger's design in

order to achieve a design that is capable of authenticating a user to participate in an electronic commerce system that utilizes electronic cash for the purposes of performing electronic exchanges.

10. Claims 13, 20 and 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Burger in view of Mansell (5223844). In regards to claim 13, Burger's design disclosed above meets all of the aforementioned limitations set forth under claim 3. However, Burger's design makes no mention of allowing the electronic system to be a notifying system for giving urgent notification to a competent center in case of an emergency. Mansell teaches in column 1, lines 53-67 that emergencies in a motor vehicle may arise and that there is a need to be able to report the emergency or request appropriate assistance. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Mansell's teachings on the need for having an electronic communication system for the purpose of being able to report emergencies into Burger's design in order to achieve a design that is capable of allowing emergencies to be reported (or even canceled) to a competent center by a user through the use of the personal authentication device.

11. In regards to claim 20, Burger further discloses a design in column 5, lines 21-23 and in figure 1 how a smart card representative of the personal authentication device can be inserted into a card reader slot that is capable of reading the aforementioned biological data (fingerprint data). This disclosure meets the exact limitations set forth under claim 20.

12. In regards to claim 25, Burger further discloses in column 4, lines 39-42 (as mentioned in the rejection of claim 3 above) that the personal authentication device can be connected to a computer of a purchaser (user) in order to authenticate the purchaser (user) before a seller on the Internet releases the desired products or services. This disclosure meets the exact limitations set forth under claim 25.

13. Claims 11, 12, 19 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burger and Rosen as applied to claims 5 and 8 above, and further in view of Maeda (5926546). In regards to claims 11 and 12, Burger and Rosen's design disclosed above meets all of the limitations set forth under claims 5 and 8. However, Burger and Rosen's design makes no mention of allowing the electronic commerce system to be an automatic charge receiving system for automatically collecting a toll (paragraphs 4 and 5 on page 6 of the applicant's specification provides an example in which the personal authentication device is used in cars for the collection/payment of tolls). Maeda discloses a design that pertains to a device for performing automatic collection of toll charges for a vehicle that travels along a road. Maeda further teaches in column 1, lines 25-28 that a toll charging system for automatically collecting a toll charge from a vehicle traveling along a toll road is well known. It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute Maeda's teachings that it is well known to have a toll charging system that automatically collects tolls from a vehicle traveling along a toll road into Burger and

Rosen's design in order to achieve a design that is capable of allowing the personal authentication device to automatically collect tolls.

14. In regards to claim 19, Burger further discloses a design in column 5, lines 21-23 and in figure 1 how a smart card representative of the personal authentication device can be inserted into a card reader slot that is capable of reading the aforementioned biological data (fingerprint data). This disclosure meets the exact limitations set forth under claim 19.

15. In regards to claim 24, Burger discloses in column 4, lines 39-42 (as mentioned in the rejection of claim 3 above) that the personal authentication device can be connected to a computer of a purchaser (user) in order to authenticate the purchaser (user) before a seller on the Internet releases the desired products or services. This disclosure meets the exact limitations set forth under claim 24.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph McArdle whose telephone number is (703) 305-7515. The examiner can normally be reached on Weekdays from 8:00 am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (703) 305-1830. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2132

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Joseph McArdle
Examiner
Art Unit 2132

jmm



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